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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/174,042	10/16/98	HIRATH J	ZTP-97-P-413

EXAMINER	
ANDERSON, G	
ART UNIT	PAPER NUMBER
3636	17

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No.	Applicant(s)	
	09/174,042	HIRATH ET AL.	
	Examiner	Art Unit	
	JERRY A ANDERSON	3636	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14* is/are pending in the application.

4a) Of the above claim(s) *13 and 14* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)
16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
18) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
19) ☐ Notice of Informal Patent Application (PTO-152)
20) ☐ Other:

DETAILED ACTION

Response to Arguments

Applicant's arguments filed March 2, 2001 have been fully considered but they are not persuasive. The applicant argues for the positional tolerance correction feature of the invention. However this is a function of any tubular section flange which engages a panel about a hole in the panel. It is well settled in case law that the mere recitation of a newly discovered function or property inherently possessed by things in the prior art does not cause a claim drawn to these things to distinguish over the prior art. The PTO may require the applicant to prove that the prior art does not possess the characteristics relied on. In re Swinehart and Sfiligoj 169 USPQ 226 (1971).

The applicant defines the field of the invention as "the art of vacuum-insulating heat block walls". The Examiner disagrees with this narrow definition. First, the field of the invention is insulated wall structures. Second, the claim 1 defines "an intermediate space that can be evacuated". Thus the claim is not limited to structures with a space which is evacuated but only one that could be evacuated.

The allegations that "dips are unacceptable", "such supports are unusable", that "heat blockage ... is entirely eliminated", that "the two types of insulation ... are in no way comparable" and that the technical base of knowledge of chemists and physicists is fundamentally different are unsupported by facts.

Just what are support pieces 10?

The applicant argues for the "positional compensator" in claim 1. There is no such limitation in claim 1.

Generally the applicant fails to show how the limitations of the claims define over the structure of the cited references.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Comstock.

Claims 1-7 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Schmidberger.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Comstock or Schmidberger in view of the ordinary skill of one versed in the art. The selection of a known material based on its suitability for the intended use is an obvious matter of design choice. Therefore the applicant's use of stainless steel would have been obvious in the pertinent art of Comstock and Schmidberger at the time of the invention and it would have been obvious for one of ordinary skill in the art to use stainless steel to make the outer layers and tube.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mr. Gerald Anderson whose telephone number is 703-308-2202. The examiner can normally be reached on Tuesday -Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Peter Cuomo can be reached on Monday -Thursday. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3597 and 703-306-3195.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The restriction is made final.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2169.

gaa
May 17, 2001

Peter M. Cuomo
Supervisory Patent Examiner
Technology Center 3600